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FACSIMILE TRANSMISSION**CONFIDENTIAL****DATE:** November 6, 2006**CLIENT-MATTER No.:** 16319-04760**To:**

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FROM: Brenda M. Simon**PHONE:** (650) 335-7198**SENT BY:** Dana Chevalier**PHONE:** (650) 943-5363

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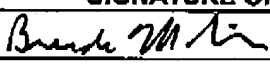
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TRANSMITTAL FORM <i>(to be used for all correspondence during pendency of filed application)</i>	Application Number	09/534,201	
	Filing Date	March 24, 2000	
	First Named Inventor	David R. Larsen	
	Group Art Unit Number	3627	
	Examiner Name	James A. Kramer	
Total Number of Pages in This Submission	11	Attorney Docket Number	4760

ENCLOSURES (check all that apply)	
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Attorney/Reg. No.:	Brenda M. Simon, Reg. No. 48,449
Dated:	11/6/06

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**FEE TRANSMITTAL
for FY 2006**

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☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT (\$)** 500.00**Complete if Known**

Application Number	09/534,201
Filing Date	March 24, 2000
First Named Inventor	David R. Larsen
Examiner Name	James A. Kramer
Art Unit	3627
Attorney Docket No.	4760

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FEE CALCULATION**1. BASIC FILING FEE**

Large Entity/Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath or declaration	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1,080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	
1403	1000	2403	500	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	500	2452	250	Petition to revive - unavoidable	
1453	1,500	2453	750	Petition to revive - unintentional	
1501	1,400	2501	700	Utility issue fee (or reissue)	
1502	800	2502	400	Design issue fee	
1503	1100	2503	550	Plant issue fee	
1460	—	1460	—	Petitions to the Director	
1807	50	1807	50	Processing fee for Provisional Applications	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

SUBTOTAL (1) (\$).00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20**	X	= 0
Multiple Dependent	-3**	X	= 0

Large Entity Fee Code	Small Entity Fee Code	Fee Description
1202 50	2202 25	Claims in excess of 20
1201 200	2201 100	Independent claims in excess of 3
1203 360	2203 180	Multiple dependent claim, if not paid
1204 200	2204 100	**Reissue independent claims over original patent
1205 50	2205 25	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$).00

*or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Fee Code	Small Entity Fee Code	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath or declaration	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 120	2251 60	Extension for reply within first month	
1252 450	2252 225	Extension for reply within second month	
1253 1020	2253 510	Extension for reply within third month	
1254 1,590	2254 795	Extension for reply within fourth month	
1255 2,160	2255 1,080	Extension for reply within fifth month	
1401 500	2401 250	Notice of Appeal	
1402 500	2402 250	Filing a brief in support of an appeal	
1403 1000	2403 500	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 500	2452 250	Petition to revive - unavoidable	
1453 1,500	2453 750	Petition to revive - unintentional	
1501 1,400	2501 700	Utility issue fee (or reissue)	
1502 800	2502 400	Design issue fee	
1503 1100	2503 550	Plant issue fee	
1460 —	1460 —	Petitions to the Director	
1807 50	1807 50	Processing fee for Provisional Applications	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 790	2809 395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 790	2810 395	For each additional invention to be examined (37 CFR 1.129(b))	
1801 790	2801 395	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify) Notice of Appeal

500

SUBTOTAL (3) (\$) 500

*Reduced by Basic Filing Fee Paid

SUBMITTED BY

Name (Print/Type)	Registration No. (Attorney/Agent)	Complete (if applicable)
Brenda M. Simon	48,449	Telephone (650)335-7198
Signature	Date	
Brenda M. Simon	11/6/06	

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 4760	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name <u>Brenda M. Simon</u>		Application Number 09/534,201	Filed 3/24/2000
		First Named Inventor David R. Larsen	
		Art Unit 3627	Examiner James A. Kramer
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/>	applicant/inventor.	Signature	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>Brenda M. Simon</u> Typed or printed name	
<input checked="" type="checkbox"/>	attorney or agent of record. 48,449 Registration number _____	(650)335-7198 Telephone number	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>11/6/06</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW IN U.S. PATENT
APPLICATION NO. 09/534,201 FILED ON MARCH 24, 2000**

Pre-appeal brief review is appropriate in this application because the rejections in the September 28, 2006 Final Office Action contain clear deficiencies. Dunn and Kreminic fail to teach or suggest a system or method for reconciling a first transaction in a first list with a combination of at least two transactions in a second list, as recited in independent claims 1, 6, and 15, and thus *prima facie* obviousness required by MPEP §2143.03 has not been established.

Claims 1-54 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Dunn in view of Kreminic. This rejection is respectfully traversed.

The independent claims 1, 6, 14, 15, 20, 21, 26, 33, 34, 39, 40, 43, 49, 50, and 54 generally recite methods, systems, and computer products for reconciling a transaction in a first list with a combination of at least two transactions in a second list, each transaction having a value. As further claimed, the method "determine[s] whether the value of the first transaction corresponds to a combination of the values of a subset of transactions in the second list."

The Examiner has made a conclusion, based on the fact that Applicants had previously filed a declaration under 37 CFR 1.131 to swear behind the Checkfree reference (cited in the Office Action dated August 15, 2005), that any aspect of Applicants' invention not specifically mentioned in the 1.131 declaration must be an obvious variation of the Kreminic reference. This is not correct. Rather, as stated in MPEP 715.02, "a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) or the identical subject matter involved in the activity relied upon. If the affidavit contains facts

showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference or the identical subject matter involved in the activity.” Thus, the determination of whether a 1.131 declaration is sufficient depends on the reference it is swearing behind. First, Applicants used the 1.131 declaration to swear behind Checkfree. The Examiner correctly determined that the declaration was sufficient to swear behind Checkfree, as the declaration contains facts commensurate with the extent of the description set forth in Checkfree.

Now, in examining whether Dunn and Kreminic are sufficient to render the invention obvious under 35 USC § 103(a), a separate determination takes place. As the MPEP makes clear, the determination of sufficiency of a 1.131 declaration depends on the showing made in the reference the Applicant is swearing behind. The determination of whether a different reference renders an invention unpatentable under 35 USC § 103(a) is not the same thing. First, Applicants are not swearing behind Dunn and Kreminic. As such, Applicants’ prior declaration under Rule 1.131 to swear behind Checkfree is simply not pertinent to the determination whether Dunn and Kreminic render the invention obvious under 35 USC § 103(a).

Moreover, even the standard for swearing behind under 35 USC § 102(a) is different from the standard of swearing behind under 35 USC § 103(a). See 1-3 CHISUM ON PATENTS § 3.08 (2006) (citing *In re Tanczn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965)) (“When a rejection under 35 U.S.C. § 102(a) is involved, we have held that ‘under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show.’ ...A different situation may prevail when the rejection is based upon

35 U.S.C. § 103. In such a case the purpose of an affidavit is to establish that the claimed invention was made by the applicant before the effective date of a reference relied upon to that the invention was obvious.”)

Kreminic and Dunn do not teach all the limitations of the claims. With regard to claims 1, 6 and 15, as the Examiner correctly acknowledges, Dunn does not discuss matching a transaction from a first list to a subset of transactions from a second list. With regard to claim 14, Dunn also does not discuss the matching of multiples or combinations (many-to-many). Dunn describes only one-to-one matching.

Kreminic does not remedy these deficiencies. With regard to claims 1, 6 and 15, Kreminic has only one pertinent sentence: “this software allows matching multiple transactions to a summary transaction, thereby reducing the number of unmatched items that require research.” At most, Kreminic discusses the software’s desired outcome, not any techniques to obtain the outcome. There is no description whatsoever of particular steps, methodology, or architecture for achieving these goals. Specifically, there is no discussion of a system or method for reconciling a first transaction in a first list with a combination of at least two transactions in a second list.

Moreover, Kreminic does not provide screenshots, code or any sort of documentation as to what the software could or could not accomplish or how any such operations were performed when the article was published. It is not clear where the system was in its development at the time the article was published. The article indicates that the system was still in the process of being developed: “In the future, we intend to expand the capabilities of this system for

maintaining and controlling various suspense [sic] accounts.” Kreminic simply does not disclose what the system could do or how it operated when the article was published.

Furthermore, such details are not the proper subject of official notice of facts not in the record or “common knowledge”, as discussed in MPEP 2144.03. As such, the Examiner’s statement that “search/matching algorithms are old and well-known in the art and have been explained and discussed for [sic] in text books as one of the fundamental coding principles” cannot be used as evidence of obviousness.

In addition, claims 6 and 15 contain detailed descriptions of how the method reconciles one-to-many transactions; this discussion is not present in either Dunn or Kreminic. The Examiner has not shown where the numerous elements of these claims are found in the references.

The Examiner states that the Kreminic article teaches “one-to-many and many-to-many searching/matching algorithms.” This is not clear from the Kreminic article. Kreminic simply does not disclose how the matching is carried out. Claim 14 recites specific steps and elements for performing the reconciliation, many of which are not disclosed by Kreminic. For example, claim 14 recites such specific steps as “combining the obtained transactions to generate first value”, “determining whether the first value corresponds to a combination of the values of a subset of transactions in the second list”, and “responsive to the first value corresponding to the combination of values, indicating a match between the first combination and the subset of transactions.” None of these specific steps and limitations is taught by Kreminic. Rather, Kreminic discloses little more than the desired goal of performing many-to-many item matching,

without any indication of how such a goal is accomplished or what steps were performed by the software at the time the article was written.

The dependent claims also recite additional features and limitations that are not taught or suggested by Dunn or Kreminic. The claims that are dependent on claims 1, 6, and 15 specify how to perform the method in great detail.

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. See MPEP §2143.03. The statement that "the Examiner can think of only two ways to perform one-to-many matching", and the attendant illustration on page 8 of the Office Action, are simply not a proper prior art reference or common knowledge, as discussed in MPEP 2144.03. Thus, no reference has been provided over the past six years, despite many opportunities for searching, that hints or suggests the specific limitations of the claimed invention necessary for an obviousness rejection under MPEP §2143.01.

Therefore, it is respectfully requested that the final rejections of claims 1-54 be withdrawn.

Respectfully submitted,
David R. Larsen

Dated: November 6, 2006

By: 

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